

REMARKS

Claims 1-4, 6-12, 14-23, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82, 106 and 108-112 are pending in the application.

The term “line item” is defined in each of the independent claims as including at least the following pair of values: “(i) *an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category* and (ii) *a corresponding benefit cost to the employee for purchasing the coverage under the benefit category*”. These parameters allow “*a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category.*” An example of the claimed “out-of-pocket cost parameter” included in the line item is a co-pay amount that an employee is required to pay each time he/she uses the coverage. An example of the claimed “benefit cost” included in the line item is a monthly cost to the employee for purchasing the coverage.

Each of the independent claims requires *simultaneous* display of a plurality of “*different*” line items (as such term is defined above) associated with a benefit category to the employee on a user interface in a manner that allows a *purchase selection* associated with one of the line items. In other words, for a given benefit category (e.g., physician care), the claims require the simultaneous display of *multiple different pairings* of “out-of-pocket cost” and “benefit cost” parameters (as such terms are defined in the claim) that may be *purchased* by the employee. An example of this aspect of Applicant’s claims is shown in Fig. 22C of the Specification, a portion of which is reproduced below:

Physician Care is that care which is provided by your physician to whom you have been referred. This care is most frequently provided in a physicians' office.

choose from the following benefits		
your <u>network</u> benefit	monthly benefit cost	your choice
\$0.00 fixed copay	\$54.30	<input type="radio"/>
\$10.00 fixed copay	\$47.42	<input checked="" type="radio"/>
\$13.00 fixed copay	\$44.78	<input type="radio"/>

In the embodiment shown in Fig. 22C, three different line items are simultaneously displayed for the “physician care” benefit category of a healthcare benefit type. Each of the three line items includes a different out-of-pocket cost parameter (i.e., a “\$0.00 fixed copay”, “\$10.00 fixed copay” or “\$13.00 fixed copay”) corresponding to an out-of-pocket cost paid by the employee for use of the physician care coverage. In addition, each of the three line items includes a different corresponding benefit cost to the employee for purchasing the physician care coverage (i.e., a “\$54.30 monthly benefit cost”, “\$47.47 monthly benefit cost” or “\$44.78 monthly benefit cost”).

The simultaneous presentation of different value pairings (i.e., the different line items) to the employee allows the employee to better understand the tradeoffs associated with, e.g., different co-pay and monthly benefit cost options for a particular benefit category such as physician care. Once the employee has been presented with the different line items, the employee makes a ***purchase selection*** that corresponds to one of the options presented (e.g., the employee clicks on the “your choice” button in Fig. 22 corresponding to the line item desired by the employee).

Turning now to the rejection of the claims as obvious over Wizig in view of Schoenbaum, the Examiner has acknowledged that Wizig fails to show the simultaneous displaying of a plurality of different line items associated with a benefit category to the employee on a user interface, wherein each of the different line items displayed on the interface includes “(i) an *out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category,*” as required by the claims. However, the Examiner has reasoned that these aspects of the claims are shown in Figures 16-17 and 22 of Schoenbaum, an example of which is reproduced below:

Level of Health Use	No Use premium only	Low Use	Moderate Use	High Use	Very High Use
PPO	\$2,533	\$2,763	\$3,285	\$4,099	\$5,726
Staff-Model HMO	\$1,008	\$1,093	\$1,230	\$1,379	\$1,552
Mixed-Model HMO	\$900	\$1,012	\$1,185	\$1,381	\$1,585
No insurance	\$0	\$606	\$2,547	\$8,092	\$35,136

Schoenbaum – Fig. 17

Significantly, neither Fig. 17 of Schoenbaum, nor the other Figures cited by the Examiner, shows the *simultaneous* display of *multiple different pairings* of “out-of-pocket cost” and “benefit cost” values (as such terms are defined in Applicant’s claims)

for *use of coverage* and *purchase of coverage* for a given benefit category to facilitate a *purchase selection* by an employee. The amounts shown in the cited Figures of Schoenbaum correspond to aggregate values that represent *lump sum estimates* of all health care expenses over a given period for different health care plans and levels of use. (See, e.g., Fig. 17 of Schoenbaum, the illustrated chart includes “*Estimates of Your Family’s Total Annual Health Care Costs*”; Paragraph [0253] “...the field[s] present dollar *estimates* of in-network costs for the user when enrolled in *different health plans*”).

Thus, in contrast to the present claims, Schoenbaum fails to show a plurality of line items where *actual* (not estimated) “out-of-pocket cost” and *actual* “benefit cost” values (as such terms are defined in Applicant’s claims) are *displayed* to allow “a *purchase selection* from the employee corresponding to one of the plurality of different line items.” In presenting aggregated lump sum estimates, rather than “out-of-pocket cost” and “benefit cost” parameters, Schoenbaum fails to provide the employee with an understanding of the tradeoffs associated with a purchase selection, e.g., different co-pay and monthly benefit cost options for a particular benefit category such as physician care.

The claimed invention allows, *inter alia*, an employee to create his own health care plan or package through “line item” selection of both the out-of-pocket cost and benefit cost corresponding to each benefit category given a plurality of “line item” choices. This is in complete contrast to Schoenbaum and Wizig both of which teach receiving personal information from an employee and displaying total comparative cost information for health care plans and health care service packages, respectively. Allowing for an employee to create his own health care plan or package by selecting a

“line item” for each of a plurality of benefit categories, after considering the relative tradeoffs, is an important feature of the claimed invention that is absent from Schoenbaum and Wizig.

Simply put, the rejection of the present claims as obvious over Wizig and Schoenbaum cannot be maintained, because neither of these references shows or fairly suggests the simultaneous displaying of a plurality of different line items associated with a benefit category to the employee on a user interface, wherein each of the different line items displayed on the interface includes separate and distinct values corresponding to “(i) *an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category*” for facilitating “a purchase selection from the employee corresponding to one of the plurality of different line items associated with the benefit category”, as set forth in the independent claims and as shown, for example, in Fig. 22C of the Specification. Indeed, there is no combination of Wizig and Shoenbaum that one could make to achieve the claimed invention. The claimed invention could not, therefore, have been obvious from the combination of Wizig and Shoenbaum at the time it was made.

Declaration Under 37 C.F.R. 1.131

In addition, Applicants enclose herewith a “Declaration Under 37 C.F.R. 1.131”, executed by the assignee of record, Choicelinx Corporation, as required by the Senior Petitions Attorney in the Decision on Petition mailed September 25, 2008, in this matter. The Declaration Under 37 C.F.R. 1.131 has been filed under seal as it contains proprietary information; as required, it is subject to the petition to expunge filed on April

9, 2008 in the event the Patent Office does not accept the Declaration Under 37 C.F.R. 1.131.

The Declaration Under 37 C.F.R. 1.131 establishes:

1. Conception of the subject matter of independent claims 1, 21, 40, 70 and 106 prior to April 25, 2000; and

2. Diligence from just prior to the filing date of Shoenbaum, April 25, 2000 to commercial release on November 15, 2000 and a subsequent constructive reduction to practice, i.e. the December 26, 2000 filing date of the present application.

The enclosed declaration establishes that a system incorporating the subject matter of independent claims 1, 21, 40, 70 and 106 was conceived prior to April 25, 2000. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 6-12. Exhibit A of the attached declaration provides evidence of conception of the subject matter of independent claims 1, 21, 40, 70 and 106, including simultaneous display of a plurality of different line items associated with a benefit category wherein each line item includes a co-pay amount and information regarding "how much each choice costs." See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 7-12. Exhibit A is dated prior to the April 25, 2000 effective U.S. filing date of Schoenbaum. See *"Declaration Under 37 C.F.R. 1.131"*, ¶8.

In addition, the declaration establishes that diligence was exercised in constructively reducing the subject matter of independent claims 1, 21, 40, 70 and 106 to practice from just prior to April 25, 2000 to the date of constructive reduction to practice, December 26, 2000. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 15-77. Exhibit B is listing of email correspondence received by and sent from Patrick Miller's email account from April 19, 2000 to December 27, 2000. See *"Declaration Under 37 C.F.R. 1.131"*,

¶¶ 14-16. Patrick Miller is an inventor of record in the present application. The subject lines of the email correspondence in Exhibit B indicate that diligent effort was being applied nearly every business day to reduce the subject matter of claims 1, 21, 40, 70 and 106 to practice during the time period from April 19, 2000 through commercial launch of the system on November 15, 2000 and to December 27, 2000. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 15-16.

Exhibits C-KK provide further evidence of diligence in reducing the subject matter of 1, 21, 40, 70 and 106 to practice. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 17-77. Exhibits D-G, for example, describe creation of focus groups and progress made toward creation of a web site for implementing a system consistent with claims 1, 21, 40, 70 and 106. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 19-28. Exhibit H shows a version of a prototype web site tested in at least one of the focus groups in or about May of 2000. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 30-32. Pages 13-20 of Exhibit H show incorporation of the subject matter of claims 1, 21, 40, 70 and 106 in the prototype web site. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 31-32.

Exhibits I-FF describe activities associated with further development of the web site to a commercial stage. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 33-68. Exhibit S, for example, discusses product development and focus group testing that occurred through August 1, 2000. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 49-53. Exhibit GG is a press release announcing public release of a commercial version of a system incorporating the subject matter of claims 1, 21, 40, 70 and 106. See *"Declaration Under 37 C.F.R. 1.131"*, ¶¶ 69-72. Exhibits HH-KK discuss further refinement of systems that would support a system incorporating the subject matter of claims 1, 21, 40, 70 and 106

after November 15, 2000. See "Declaration Under 37 C.F.R. 1.131", ¶¶ 73-78.

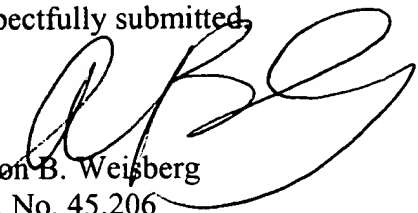
Constructive reduction to practice of claims 1, 21, 40, 70 and 106 occurred on December 26, 2000 with filing of the present application.

In view of the attached "Declaration Under 37 C.F.R. 1.131" Applicants respectfully submit that Schoenbaum may not be cited as prior art to independent claims 1, 21, 40, 70 and 106. *MPEP 715.02(I)*. Applicants request, therefore, that the rejections of independent claims 1, 21, 40, 70 and 106, and the claims which depend therefrom, as being obvious in view of Wizig combined with Shoenbaum be withdrawn upon reconsideration.

In view of the foregoing amendments and remarks, it is respectfully submitted that all independent claims are allowable over the cited references. All dependent claims depend from an allowable base claim, and are therefore also allowable. A Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fee due in connection with this filing, including any fees for extra claims, to Deposit Account 50-0310.

Respectfully submitted,


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Date: Dec 5, 2008